

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Bert W. Elliott GAU 3635; Conf. No. 1357
Serial No.: 09/515,928 Examiner: Robert Canfield
Filed: February 29, 2000 Attorney Docket No.: 24673A
For: SHINGLE FOR OPTICALLY
SIMULATING A SLATE ROOF

DECLARATION UNDER 37 CFR 1.132

Mail Stop Amendments
Commissioner for Patents, P.O. Box 1450
Alexandria, VA 22313-1450
State of Ohio, County of Lucas

Bert W. Elliott, being duly sworn, deposes and says:

1. I am a 1981 graduate of Miami University of Ohio in Oxford with a Bachelor of Environmental Design, and a 1983 graduate of the University of Illinois at Champaign-Urbana, with a Master of Architecture and a Master of Business Administration. I am a Registered Architect in the State of Minnesota.
2. Prior to joining Owens Corning, I was a custom home designer and contractor in Minneapolis and a sales representative of architectural metal products.
3. I joined Owens Corning in 1992 as an Area Sales Manager selling commercial and residential roofing products. I have held various other positions in sales, technical, and financial areas.

4. In 1999, I started with the Roofing Division as a Project Leader focusing on the development of new roofing products. I led the design and technical development of the new Berkshire®, Woodcrest™ and Woodmoor™ premium shingle products.

5. I am named as the inventor on numerous patents and pending applications for roofing products, and in particular for asphalt shingle products. I am the inventor named on the above-identified pending patent application.

6. In order to better serve the residential roofing market, Owens Corning has developed several asphalt shingle products that provide the look or appearance of more expensive roof coverings. By using creative and innovative designs for asphalt shingles, Owens Corning can offer the customer the look or appearance of more expensive roofing products, while still giving the customer the benefits of low cost and high performance of asphalt material.

7. As an example, Owens Corning developed the Prominence® shingle having strong shadow lines to create a look of added depth and beauty on a roof to simulate a wooden shake appearance. The installed cost of the Prominence asphalt shingle is lower than that of wooden shakes, and the asphalt shingles offer a superior fire rating.

8. The subject matter of the above-identified application, which is an asphalt shingle and roofing system that simulates a natural slate roof, is another design intended to simulate a higher-priced roofing product at a lower cost.

9. In one embodiment of the invention, as defined in the claims of the above-identified patent application, the shingles are provided with an overlay, having tabs and cutouts, and an underlay. Each cutout is narrow when compared to the width of the tabs to provide an overall roof covering appearance of a natural slate roof. When the shingles are installed on a roof to form a roof covering, the shingles are installed in a plurality of successive generally horizontal courses of laminated shingles, the shingles in each course

being laid in a side-by-side relationship and horizontally offset from the shingles in adjacent courses. Each tab is provided with a color blend of granules so that each tab has a single color blend different from the color blend of others of the tabs. When installed on a roof, each tab takes on the appearance of an individual slate tile, and the roof covering of such shingles gives the appearance of a plurality of adjacent slate roof tiles. The fact that the color blend of some of the tabs differs from the color blend of other tabs gives the appearance of a roof where some of the slate tiles differ in color from others of the slate tiles. Further, one of the color blends of the tabs of the shingles occurs more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend so that the appearance of the roof covering simulates a natural slate roof. This provides an aesthetically pleasing appearance as a roof covering. Customers are willing to pay a premium price over standard shingles to achieve this appearance, particularly since the installed cost of genuine or natural slate roofs is extremely high.

10. In a specific embodiment of the invention, as defined in claims 46, 56 and 68, roughly 60 percent of the tabs have a predominant tab color blend. In another specific embodiment of the invention, as defined in claims 52, 62, and 69, over 50 percent of the tabs have a predominant tab color blend. In both of these embodiments, the resulting predominant tab color blend provides the appearance of the roof covering simulating a natural slate roof, thereby providing an aesthetically pleasing appearance as a roof covering. Customers are willing to pay a premium price over standard shingles to achieve this appearance.

11. Owens Corning began marketing the Berkshire shingle, which simulates a natural slate roof, in January, 2003 to offer to its customers such a desirable appearance at an installed cost substantially below that of conventional natural slate roofs.

12. The Berkshire shingle is illustrated in the Owens Corning marketing brochure entitled "Berkshire Collection", a copy of which is attached as Exhibit A. It can be seen that a roof covering of the Berkshire shingles has the aesthetically pleasing appearance of a more expensive natural slate roof, and therefore the Berkshire shingle is a product of great demand by customers in the residential shingle market.

13. Owens Corning began selling the Berkshire shingle to its customers in February, 2003. The Berkshire shingles were enthusiastically received in the residential shingle market, and sales in 2004 exceeded \$3 Million.

14. Since their introduction in February 2003, sales of Owens Corning's Berkshire shingles have experienced strong growth, thereby highlighting the fact that Berkshire shingles fulfilled a long felt need in the marketplace.

15. The solid growth of the Berkshire shingles has occurred without any significant advertising over and above normal marketing efforts for Owens Corning shingle products, and is attributable to, and directly derived from, the unique concept of simulating a natural slate roof by forming the shingles with tabs of substantially uniform color and having the color of some of the tabs differing from the color of other tabs, and by having one of the color blends of the tabs occurring more frequently than any of the other color blends, thereby defining a predominant tab color blend so that the appearance of the roof covering simulates a natural slate roof.

16. Additional evidence of the commercial success of the Berkshire shingles includes the fact that the market place is sustaining a price of about \$120 per square for Berkshire® shingles (i.e., sales price to the contractor), whereas the equivalent price for Oak Ridge PRO 50® shingles is only about \$60 per square. The Berkshire shingles carry a Lifetime Limited warranty and a 110 mph wind warranty, while the warranty for Oakridge PRO 50 is only 50

years with a 90 mph wind warranty. Based on the warranties alone one would expect the difference in price to be only about \$20 per square rather than \$60 per square, resulting in a net price premium of about \$40 per square.

17. In approximately June 2004 CertainTeed Corporation, an Owens Corning competitor, copied Owens Corning's concept of an asphalt shingle that simulated a slate roof, and began selling shingles similar to Owens Corning's Berkshire shingles under the brand name Centennial SlateTM. A CertainTeed marketing brochure, entitled "Centennial*TMSlate", illustrates the Centennial Slate shingles. A copy of the brochure is attached as Exhibit B.

18. The fact that CertainTeed copied Owens Corning's concept of making a slate-looking roof by making the overall roof covering have predominant tab color blend is additional evidence commercial success of the invention claimed in the above-identified patent application.

19. As a result of the introduction of the CertainTeed Centennial Slate shingles, Owens Corning began to lose market share to CertainTeed in this market segment, and the sales of Owens Corning Berkshire shingles dropped in 2005 relative to sales in 2004.

20. I further note that one of the patent references cited against the claims in the above-identified patent application is U.S. Patent No. 1,843,370 to Overbury. The Overbury reference, a copy of which is attached as Exhibit C, discloses applying additional granular material to shingles to cover surface imperfections. Overbury specifically discloses that the additional granules may be configured so that the tabs of a shingle may be of different colors, with each tab having a single color blend different from the color blend of the other tabs on the shingle. Overbury further states at page 2, lines 93-96, that "...each tab will have a solid color different from other tabs in the strip, although if desired two or more adjacent tabs may now and then be given the same color." I believe that one skilled in the art of shingle design, such as myself, would interpret this statement, as I interpret this statement, as limiting the occurrence

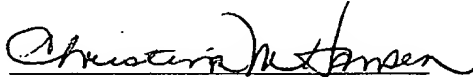
of multiple tabs of the same color in the same shingle to occasional occurrences, occurring seldomly. As a result, I would not expect the resulting roof covering to have a predominance of one color. "Now and then" would connote only infrequent deviations from the norm, and therefore there will be no predominant color for the resulting roof covering. Without a predominant color, the resulting roof covering would not have the appearance of a natural slate roof, and therefore the product would not be meeting the needs of the customers.

21. I hereby declare that all statements made in this declaration of my own knowledge are true, and that all statements made on information or belief are believed to be true; and further, all these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application and any patent issued from the application.



Bert W. Elliott

Sworn and subscribed before me
this 20th day of July, 2006.



Christina M. Hansen

Notary Public

Christina M. Hansen
Notary Public State of Ohio
My Commission Exp. 7/30/2008